

REMARKS/ARGUMENTS

Claims 1, 3, 4, 7, 14, 16, 18, 20, 21, 24 and 27-36 remain in the application for further prosecution. Claims 2, 5, 6, 8-13, 15, 17, 19, 22, 23, 25 and 26 have been cancelled. Claims 27-36 have been added.

Claim Rejections – 35 U.S.C. § 102

Claims 1-5, 14-16 and 18-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Publication No. 2003/0036427 to Brandstetter (“Brandstetter”). The Office Action alleges that Brandstetter discloses the invention. The Applicant respectfully disagrees on the basis that significant claim features are missing from Brandstetter. One requirement of a *prima facie* case of obviousness is that the prior art references must teach or suggest all of the claim limitations. The missing claim features and limitations are addressed below.

Not All Claim Limitations Taught Or Suggested

The Office Action states that Brandstetter discloses a predetermined criterion that includes “*. . . selected outcome being a predetermined one or more of the plurality of possible outcomes as recited in claim 2, 15 and 19, . . .*” (Office Action, pages 2-3.) In fact, however, Brandstetter dispenses a ticket only in response to the wager of a predetermined number of coins on the gaming machine, and not in response to the game outcome. (Brandstetter, page 2, ¶¶ 11-12.) The game outcome is irrelevant to Brandstetter for purposes of dispensing a ticket.

This is in sharp contrast to independent claims 1, 14 and 18 (now rewritten to incorporate the limitations previously contained in cancelled dependent claims 2, 15 and 19) that tie the dispensing of an entry directly to the outcome of the wagered game. Each of these independent claims requires dispensing a tangible sweepstakes entry from the gaming machine in response to

the selected game outcome being a predetermined one or more of the plurality of possible game outcomes. (Claims 1, 14 and 18.) Brandstetter is missing the fundamental limitation of receiving a sweepstakes entry *in response to the selected game outcome being a predetermined one or more of the plurality of possible game outcomes*. This missing element overcomes the 35 U.S.C. § 102(b) rejection.

In fact, Brandstetter teaches away from the present invention by dispensing a ticket based solely on the number of wagers placed regardless of game outcome. In contrast, independent claims 1, 14 and 18 only dispense a sweepstakes entry when the player earns the award based on game outcome.

Furthermore, any proposed modification to include the present invention's limitation of dispensing sweepstakes entries based on game outcome impermissibly changes Brandstetter's principle of operation. Brandstetter dispenses tickets regardless of game outcome based on the number of wager inputs. In contrast, independent claims 1, 14 and 18 only dispense sweepstake entries based on game outcome. To implement any proposed modification destroys Brandstetter's principle of operation of providing a ticket regardless of game outcome. For all of the above reasons, the Applicant maintains that the claims are novel and non-obvious over Brandstetter.

New Claims 27-36

New claims 27-36 have been added by this amendment. Each of the new independent claims triggers the dispensing of a sweepstakes entry based on an operational parameter unrelated to Brandstetter's methodology based on the number of wager inputs. Each of these operational parameters in independent claims 27-36 is as follows: independent claim 27 dispenses an entry

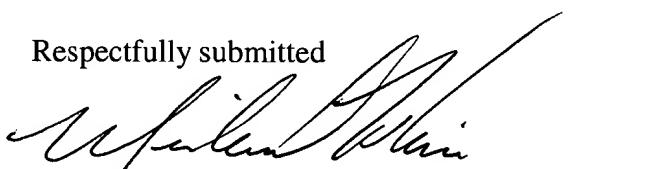
in response to at least one winning outcome, independent claim 28 dispenses an entry in response to a predetermined number of plays associated with a predetermined game outcome, independent claim 31 dispenses an entry in response to exceeding a predetermined wager, independent claim 32 dispenses an entry in response to wagering on all available pay lines, independent claim 33 dispenses an entry in response to predetermined player tracking information criteria, independent claim 34 dispenses an entry at a predetermined time of day.

Brandstetter does not disclose any of the above limitations for triggering the dispensing of a ticket. Furthermore, none of the new independent claims are related to Brandstetter's method of dispensing a ticket based on the number of wager inputs. Each of the new independent claims contains a limitation (listed above) that is not found in Brandstetter. Consequently, the Applicant maintains that the claims are novel and nonobvious over Brandstetter.

Conclusion

It is the Applicant's belief that all of the claims are now in condition for allowance, and action toward that end is respectfully requested. If any matters may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number shown.

Respectfully submitted



Michael L. White
Reg. No. 39,421
(773) 961-1267
Attorney for Applicant

Date: September 7, 2003